

### **REMARKS**

Claims 1-20 are pending with claims 1, 12, and 17 being independent. Claims 1, 3-4, 8-12, and 17 have been amended and new claims 21-26 have been added. Reconsideration and allowance of this application are requested in view of the amendments and the following remarks.

### **Drawings Objections**

An objection was made to the drawings as failing to comply with 37 C.F.R. § 1.84(p)(4). In particular, the objection states that reference characters 110 and 210 are used to designate a host system, reference characters 135 and 235 are used to designate a host device, reference characters 140 and 240 are used to designate a host controller, and reference characters 150 and 255 are used to designate communication pathways. The objection is respectfully traversed.

Each of Figs. 1-6 stands on its own, and each represents a separate implementation. In each of Figs. 1-6, only one reference character is used to designate a given part. For instance, in the implementation of Figure 1, a host system is designated by reference character 110. In the implementation of Figure 2, a host system is designated by reference character 210. As explained in the specification at page 6, lines 12-14, "the host system 210 . . . typically [has] . . . attributes comparable to those described with respect to host system[] 110 . . . of Fig. 1."

The other reference characters included in the drawing objection are similarly situated. In each case, the reference characters are being used to designate different parts. Therefore, the reference characters that are the subject of the objection are proper because multiple reference characters are not being used to designate the same part.

Therefore, it is respectfully requested that the objection to the drawings be withdrawn.

### **35 U.S.C. § 102(e) Peterson Rejection**

Claims 1, 3, 6, 7 and 11-17 were rejected as being anticipated by Peterson. This rejection is respectfully traversed.

Applicants' independent claim 1 is directed to "a method of alerting a client of a state change at a remote server" and recites, among other features, "creating a user profile including a request to receive at least one alert corresponding to a state change at [a] remote server," "retrieving data corresponding to the state change from the remote server," and "using the retrieved data to deliver the content behind the alert to the client." Applicants respectfully submit that Peterson is silent with regard to at least these features of claim 1.

Peterson discloses a client-based system directed to retrieving and organizing content from the World Wide Web (hereinafter web) in a manner that attempts to reduce impact on overburdened servers and slow networks. (col. 4, lines 9-16.) In particular, the client-based system of Peterson employs a scheduling subsystem to schedule a time for the client to obtain designated content from the web. (col. 4, lines 17-28.) As described by Peterson, the user designates the content to be retrieved using a graphical user interface which presents, among other options, general categories such as "News and Technology", "Sports", "Business", "Entertainment", "Lifestyle and Travel", "The Microsoft Network", and "MSNBC". After the user has selected the content to be received, the client-based system stores the user's preferences in a preference store. (col. 10, lines 11-24.) When the scheduled time arrives, the scheduling subsystem issues an event notification instructing a delivery subsystem to retrieve the designated content from the web. (col. 4, lines 29-39.) In response, the delivery subsystem retrieves the designated web content and an index summarizing the web content and stores the content and index in system cache. (col. 4, lines 40-46.)

Peterson neither describes nor suggests "a method of alerting a client of a state change at a remote server." Instead, the system described by Peterson is merely concerned with scheduling a particular time for the client to retrieve content from the

web. In Peterson, it is irrelevant whether “a state change” has occurred at a “remote server.” Indeed, the system of Peterson will retrieve web content at the scheduled time whether or not “a state change” has occurred. In other words, in Peterson, the client-based system polls the web for content at specific, predetermined times. It is not concerned with “alerting [the] client of a state change.”

Furthermore, the client-based system of Peterson neither describes nor suggests “creating a user profile including a request to receive at least one alert corresponding to a state change at [a] remote server.” While Peterson does disclose storing a “user’s preferences” in a “preference store,” the user’s preferences contemplated by Peterson relate to general categories of content (e.g., news, sports, business, etc.) to be retrieved from the web. The user’s preferences described in Peterson therefore do not include “a request to receive [an] alert corresponding to a state change.”

Moreover, Peterson does not disclose “retrieving data corresponding to the state change from the remote server.” The system described by Peterson does retrieve data. However, as discussed above, that data is general web content and it will be retrieved at the scheduled time whether or not “a state change” has occurred. Therefore, the web content retrieved in Peterson does not “correspond[] to the state change” designated in the user profile as contemplated by claim 1. In addition, the data retrieved in Peterson is explicitly limited to web content. In contrast, the data retrieved in claim 1 is not limited to web content but includes any “data corresponding to the state change” stored on the “remote server.”

Finally, the client-based system described in Peterson neither describes nor suggests “using the retrieved data to deliver the content behind the alert to the client.” As discussed above, the data retrieved in Peterson is general web content, not data intended “to deliver the content behind [an] alert to the client.” For the foregoing reasons, Applicants submit that claim 1 is patentable over Peterson. In addition, claims 3, 6, 7 and 11 depend either directly or indirectly from claim 1 and are believed to be allowable for at least the reasons given for claim 1.

Applicants' independent claim 12 is directed to "a computer program for alerting a client of a state change at a remote server, stored on a computer readable medium" and recites, among other things, instructions for "creating a user profile including a request to receive at least one alert corresponding to a state change at a remote server," "retrieving data corresponding to the state change from the remote server," and "using the retrieved data to deliver the content behind the alert to the client." As discussed in detail in connection with claim 1 above, Applicants respectfully submit that Peterson is silent with regard to at least these features of claim 12. Accordingly, Applicants submit that claim 12 is patentable over Peterson. In addition, claims 13-16 depend directly from claim 12 and are believed to be allowable for at least the reasons given for claim 12.

Applicants' independent claim 17 is directed to "a state change alert apparatus for alerting a client of a state change at a remote server," and recites, among other things, a client configured to "create a user profile including a request to receive at least one alert corresponding to a state change at the remote server," to "retrieve data corresponding to the state change from the remote server," and to "use the retrieved data to deliver the content behind the alert to a client." As discussed in connection with claims 1 and 12 above, Applicants respectfully submit that Peterson is silent with regard to at least these features of claim 17. Therefore, Applicants submit that claim 17 is patentable over Peterson.

As Peterson does not describe each and every element of claims 1, 3, 6, 7 and 11-17, it cannot serve as a basis for valid rejection under Section 102. Therefore, Applicant respectfully requests reconsideration and withdrawal of the rejection of claims 1, 3, 6, 7 and 11-17.

#### **35 U.S.C. § 103(a) Peterson/Wick Rejection**

Claims 2, 4 and 5 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of Wick. This rejection is respectfully traversed.

As an initial matter, Applicants point out that the Wick patent does not constitute statutory prior art under 35 U.S.C. § 103. § 103(c) states:

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

The Wick patent, which was not invented by the Applicants, qualifies as statutory prior art only under 35 U.S.C. § 102(f). In addition, the subject matter of the Wick patent was assigned to America Online, Inc. of Dulles, Virginia on November 1, 1999. (This assignment was recorded in the USPTO on December 1, 1999 at Reel/Frame 010413/0251.) Furthermore, at the time the Applicants' invention was made, Applicants were under an obligation to assign the invention to America Online, Inc. of Dulles, Virginia. (Applicants assigned the subject matter of this application to America Online, Inc. of Dulles, Virginia on March 25, 2001. This assignment was recorded in the USPTO on January, 13, 2003 at Reel/Frame 013657/0556.) Therefore, under 35 U.S.C. §103(c), the Wick reference does not constitute statutory prior art for purposes of 35 U.S.C. §103.

Moreover, even if the Wick patent constituted statutory prior art, Applicants submit that claims 2, 4 and 5 are patentable over Peterson in view of Wick. Claims 2, 4 and 5 depend from independent claim 1 and are directed to "a method of alerting a client of a state change at a remote server." As discussed in detail in connection with claim 1 above, Peterson neither describes nor suggests the "method of alerting a client of a state change at a remote server" of claim 1. Wick fails to address the noted shortcomings of Peterson, and in fact, Wick was not relied upon to cure those shortcomings. Accordingly, even if a person having ordinary skill in the art modified the client-based system of Peterson by incorporating the instant messaging system described by Wick, the resulting system would not read on claims 2, 4 and 5.

As Wick does not constitute statutory prior art under 35 U.S.C. § 103 and because Peterson and Wick taken in combination do no establish a *prima facie* case of

obviousness with regard to claims 2, 4 and 5, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 2, 4 and 5.

### **35 U.S.C. § 103(a) Peterson/Payne Rejection**

Claims 8-10 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Peterson in view of Payne. This rejection is respectfully traversed.

Applicants' claim 8 depends from independent claim 1 and is directed to "a method of alerting a client of a state change at a remote server" "wherein the alert corresponds to a change at a remote mail server." As discussed in detail in connection with claim 1 above, Peterson neither describes nor suggests "alerting a client of a state change at a remote server." In fact, the system described by Peterson is merely concerned with scheduling a particular time for the client to retrieve content from the web. Payne fails to address the noted shortcomings of Peterson, and in fact, Payne was not relied upon to cure those shortcomings. Accordingly, even if a person having ordinary skill in the art were to implement a mail server as taught by Payne in the system of Peterson, the resulting system would not satisfy the limitations of claim 8. Indeed, the resulting system would merely retrieve content from the mail server at scheduled times; it would not "alert[ the] client of a state change" at the mail server. That is, the resulting system would retrieve content from the mail server at the scheduled times whether or not "a state change" had occurred. Applicants therefore submit that claim 8 is patentable over Peterson in view of Payne.

The same argument holds for claims 9 and 10. Claims 9 and 10 are directed to "a method of alerting a client of a state change at a remote server" "wherein the alert corresponds to a change at a remote weather server" and "a remote stock server." Even if a person having ordinary skill in the art were to implement a weather server or a stock server as taught by Payne in the system of Peterson, the resulting system would not read on either claim 9 or claim 10. Indeed, the resulting system would merely retrieve content from the weather server or the stock server at scheduled times; it would not "alert[ the]

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client of a state change” at the weather server or the stock server. Thus, the resulting system would retrieve content from the weather server or the stock server at the scheduled times whether or not “a state change” had occurred. Applicants therefore submit that claims 9 and 10 are patentable over Peterson in view of Payne.

As Peterson and Payne taken in combination do not establish a *prima facie* case of obviousness with regard to claims 8-10, Applicants respectfully request reconsideration and withdrawal of the rejection of claims 8-10.

#### **Rejection of Claims 18-20**

Claims 18-20 were rejected as being unpatentable for not teaching or defining any additional limitations over claims 1-17. This rejection is respectfully traversed. Claims 18-20 are allowable for at least the reasons articulated with respect to claims 4-6, respectively.

The fact that applicant has not responded to any stated positions of the Examiner should not be construed as a concession by applicant of those positions. The inclusion by applicant of arguments for patentability should not be construed as a concession by the applicants that there are not other good reasons for patentability of these claims or other claims.


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Enclosed is a \$108 check for excess claim fees and a \$980 check for the Petition for Extension of Time fee. Please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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